

REMARKS

I. STATUS OF CLAIMS

Claim 27 is currently pending. No amendments are made by this Reply.

II. REJECTIONS UNDER 35 U.S.C. § 103

A. Bhatt in view of Ramin and Mougin

The Office rejects claim 27 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,106,808 to Bhatt et al. ("Bhatt") in view of U.S. Patent No. 5,683,681 to Ramin et al. ("Ramin"), and WO 97/25021 to Mougin et al. ("Mougin")¹. Office Action at page 2. According to the Office, Bhatt teaches administering a composition of a polyurethane resin, Gantrez A425, AMP, ethanol, and water for setting hair. Office Action at page 2. Admittedly, Bhatt is deficient in that it fails to teach a composition comprising a film-forming polymer or that the polyurethane has a polysiloxane segment. *Id.* at page 3. Accordingly, Bhatt certainly does not teach a composition having an average diameter of less than or equal to 80 microns, as claimed.

To cure these deficiencies, the Office relies on the teachings of Ramin and Mougin. Ramin is used to teach film-forming polymers of butyl esters. *Id.* Mougin is used to teach a copolymer of polyurethane and polysiloxane that can be used as a film former, or as an additive to a film forming agent for hair treatment. *Id.* According to the Office, the motivation for combining the teachings of Bhatt and Mougin is based on the fact Mougin teaches the copolymers have superior properties as film-forming agents

¹ Reference is made in this response to U.S. Patent No. 6,395,265, which is the English language equivalent for this Mougin reference.

and useful in aerosol form. *Id.* at page 4. Further, allegedly there is motivation to combine Bhatt with Ramin because of “an expectation of success in imparting good hair setting retention and achieving a natural feel to the sprayed hair.” *Id.* Thus, the Office concludes that based on the combined teachings, the present invention is obvious. *Id.* Applicant respectfully disagrees and traverses the rejection for the following reasons.

To establish a *prima facie* case of obviousness, the Office must, *inter alia*, provide a motivation or suggestion to combine the cited reference teachings, as well as provide an expectation of success in such a combination. M.P.E.P. § 2143 (8th ed. Rev. 3, 2005). Here, the Office claims a motivation to combine the cited references of Bhatt and Mougin “because the copolymers disclosed by Mougin et al. and as herein claimed, are known to provide superior properties as film forming agent or film forming additive for hair products and is particularly known to be useful in aerosol form.” Office Action at pages 3, 4. This not only ignores but it contradicts teachings of Bhatt and Mougin.

For example, Bhatt teaches hair compositions comprising carboxylated polyurethane resins. Bhatt at Abstract; Col. 4, ll. 3-18. These carboxylated polyurethane resins are “hydrophobic, yet provide good hair set retentions, while imparting a *soft, natural, and nontacky* feel to treated hair.” *Id.* at Col. 4, ll. 12 (emphasis added). Bhatt, however, further teaches that in addition to these carboxylated polyurethane resins, the compositions can also include an “*optional* second hair fixative resin [that] gives treated hair a desired degree of *stiffness*.” *Id.* at Col. 5, ll. 6, 7 (emphasis added); *see also id.* at Col. 11, line 66-Col. 12, line 1. Thus, Bhatt’s compositions include a carboxylated polyurethane resin imparting “a soft, natural

and nontacky feel” and may also include an optional second hair fixative resin to impart “stiffness.”

On the other hand, Mougin teaches that silicones “provide excellent surface properties, leading to good lubrication, good sheen and a *soft feel* without providing fatty substances.” Mougin at Col. 2, ll. 11-13 (emphasis added). Mougin, however, notes that silicones have a disadvantage of not having “good mechanical properties for ensuring good film-formation.” *Id.* at Col. 2, ll. 13-15. As a result, Mougin teaches the addition of “the mechanical and/or adhesion properties provided by the polyurethanes and/or polyureas.” *Id.* at Col. 2, ll. 61, 62.

Based on the Office’s rationale, a person of ordinary skill in the art would have to do some *selective* picking and choosing to arrive at the present invention considering the over detailed teachings of Bhatt and Mougin. For example, in one instance, the Office relies on Bhatt’s teaching of polyurethanes to be used to impart “a soft, natural and nontacky feel” but in order to include the silicone from Mougin, one would have to use the polyurethane to add “mechanical and/or adhesion properties” to the silicone composition. Then, the Office expects that same skilled artisan to rely on Bhatt’s teaching of a second optional fixative resin to add even more “stiffness” to the combined composition. There is nothing to guide the skilled artisan to make such a combination.

Arguably compounds and/or resins may have dual functionality, but there is nothing in Bhatt or Mougin to suggest or teach this leading to the present combination. Instead, Bhatt and Mougin teach the inclusion of polyurethanes for distinctly different purposes and would lead one to a different composition if each teaching were to be followed. Thus, there is nothing to suggest or motivate the combination of the two

reference teachings but for the present invention, which is impermissible under Section 103. *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, . . . the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”). Rather than support the Office’s argument with facts and law, the rejection is based on selective picking and choosing from the references in order to create the claimed invention, while impermissible ignoring the art as a whole. *In re Wesslau*, 147 U.S.P.Q. 391, 393 (Fed. Cir. 1965).

Ramin does nothing to cure the foregoing deficiencies. Indeed, as shown in Example 1, the only time this reference describes a diameter of the composition it is with respect to “beads” having a size ranging from 0.5 to 1.0mm. Absent the improper reliance on Applicants’ disclosure, one could logically conclude that film-forming polymers comprising butyl esters described in Ramin would lead to much larger “beads” rather than a composition having an average diameter less than or equal to 80 microns.

For at least these reasons, the Office fails to establish a *prima facie* case of obviousness and as such, Applicant respectfully request the withdrawal of the rejection.

B. Mougin in view of Bhatt and Malawer

The Office also rejects claim 27 under 35 U.S.C. § 103(a) as unpatentable over Mougin in further view of Bhatt and U.S. Patent No. 5,458,871 to Malawer et al. (“Malawer”). Office Action at page 4. According to the Office’s rationale, Mougin teaches copolymers of polyurethane and polysiloxane but does not teach an aerosol

device with droplets of 80 μm . *Id.* at page 5. To cure this deficiency, Bhatt is used to teach hair spray compositions with spray particle sizes of about 20 to 150 microns. Malawer is then used to demonstrate that it is generally recognized in the art that small droplet size is desirable. *Id.* Based on these teachings, the Office concludes that it is obvious “to prepare a hair style aerosol composition with the block copolymer of Mougine et al. and with additional film forming agent, in a device so that an optimal and desirable droplet size would be generated.” *Id.* Applicant respectfully disagrees and traverses this rejection for the following reasons.

Although the Office provides that it is obvious “to prepare a hair style aerosol composition with the block copolymer of Mougine et al. and *with additional film forming agent*, in a device so that an optimal and desirable droplet size would be generated,” it fails to indicate from which reference the “additional film forming agent” is taught. *Id.* at page 4. Applicant respectfully requests clarification as to which reference is being used to teach this element. While not part of this rejection, the Office previously relied on Ramin for its alleged teachings on film-forming polymers of butyl esters. However, Ramin clearly describes compositions comprising these film-formers as being “beads” having a size ranging from 0.5 to 1.0mm. Thus, even if this reference constituted part of the rejection, it would not render obvious the claimed invention.

To fully respond to this rejection and in view of the teachings used in the rejection of Bhatt in view of Ramin and Mougine, Applicant has assumed that the Office is relying upon Bhatt’s teaching of the optional second fixative resin, as found in Bhatt at Col. 11, ll. 45-51. Even with that assumption, Applicant arrives at the same conclusion as detailed above in Bhatt in view of Ramin and Mougine rejection, i.e., the Office fails to

establish a *prima facie* case of obviousness because neither Bhatt nor Mougin suggests such a combination. As such, based on the rationale detailed above, the Office fails to establish a suggestion or motivation to combine the teachings of Mougin and Bhatt, alone or with Malawer. Accordingly, Applicant respectfully requests the withdrawal of the rejection.

III. CONCLUSION


In view of the foregoing Remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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